



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,923	11/24/2003	Roger Bruce Harding	01313/100F022-US3	1897
7278 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770	7590 05/07/2008		EXAMINER WHITE, EVERETT NMN	
			ART UNIT 1623	PAPER NUMBER
			MAIL DATE 05/07/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/722,923

**Applicant(s)**

HARDING ET AL.

**Examiner**

EVERETT WHITE

**Art Unit**

1623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34, 36-41, 43-50 and 55-73 is/are pending in the application.
- 4a) Of the above claim(s) 4-10, 24-34, 36-41, 43-50, 55-70, 72 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-18, 20-23, 43 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed February 19, 2008 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 1, 11-15, 17, 20-23, 26-34, 36-38 and 71 have been amended;
  - (B) Claims 35, 42 and 51-54 are canceled;
  - (C) Comments regarding Office Action have been provided drawn to:
    - (I) 102(b) rejection, which has been withdrawn;
    - (II) 103(a) rejection, rendered moot by new ground of rejection over newly cited US Patent.
2. Claims 1-34, 36-41, 43-50 and 55-73 are pending in the case; Claims 4-10, 24-34, 36-41, 43-50, 55-70, 72 and 73 are withdrawn from consideration as being drawn to non-elected inventions and non-elected species.

### ***Answer to Arguments with Traverse***

3. Applicant's election with traverse of species sulfite pulp and carboxymethyl cellulose in the reply filed on August 14, 2008 is acknowledged. The traversal is on the ground(s) that additional claims not considered for examination in the Office Action filed November 16, 2008 contains the elected species. It is noted that the species cellulose ethers (carboxymethyl cellulose) were only recited in non-elected inventions at the time of the restriction requirement. It is also noted that a list of claims readable on the elected species was not included with Applicants response to the restriction/election requirement filed August 14, 2008. However, upon the allowance of a generic claim, Applicants will be entitle to consideration of claims to additional species (i.e., cellulose pulp species) which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

#### ***New Ground of Rejection***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 1623

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 11-18, 20-23, 43 and 71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to amended claims herein has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for "a method of preparing cellulose ethers that specify sequential steps and a step that involve mercerizing previously unmercerized cellulose pulp" as recited in instant Claims 1 and 71. Claims 2, 3, 11-18, 20-23 and 43 are rejected since these claims are dependent from Claim 1.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

6. Applicant's arguments with respect to Claims 1-3, 11-18, 20-23, 43 and 71 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1623

8. Claims 1-3, 11-18, 20-23 and 71 stand rejected under 35 U.S.C. 102(e) as being anticipated by Hyatt et al (US Patent No. 6,057,438) for the reasons disclosed on pages 2 and 3 of the Office Action filed November 16, 2007.

9. Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the claims as amended do not permit a xylanase treatment after mercerization of the cellulose pulp (step (a) in pending claim 1) and before derivatization of the cellulose (steps (c) and (d) in claim 1) as in the Hyatt process. This argument is not persuasive since the process of the Hyatt et al patent still discloses the instantly claimed process steps and since the language of the instant claims as amended do not exclude other process steps such as the xylanase treatment that is included with the cellulose ether preparation disclosed in the Hyatt et al patent. Accordingly, the rejection of Claims 1-3, 11-18, 20-23 and 71 under 35 U.S.C. 102(e) as being anticipated by the Hyatt et al patent is maintained for the reasons of record.

***Claim Rejections - 35 USC § 103***

10. Claim 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hyatt et al (US Patent No. 6,057,438) for the reasons disclosed on page 4 of the Office Action filed November 16, 2007.

11. Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive. Applicants argument against the rejection of Claim 43 is not persuasive and is maintained for the same reasons presented in the argument of the claims above under the 102(e) rejection for the Hyatt et al patent.

12. Claims 4-10, 19, 24-34, 36-41, 44-46, 72 and 73 are withdrawn from consideration since these claims are drawn to cellulose pulp other than sulfite pulp, which are the elected species selected by Applicants due to the Election of Species requirement filed June 27, 2006.

13. Claims 47-50 and 55-70 are drawn to non-elected inventions and are withdrawn from consideration.

***Reply To Final Must Include Cancellation of Claims Non-elected With Traverse***

14. This application contains Claims 47-50 and 55-70 are drawn to an invention nonelected with traverse in the reply filed on August 14, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Summary***

15. Claims 1-3, 11-18, 20-23, 43 and 71 are rejected; Claims 4-10, 19, 24-34, 36-41, 44-46, 72 and 73 are withdrawn from consideration due to being drawn to non-elected species; Claims 47-50 and 55-70 are withdrawn from consideration due to being non-elected inventions; and Claims 35, 42 and 51-54 have been canceled.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1623

***Examiner's Telephone Number, Fax Number, and Other Information***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/  
Examiner  
Art Unit 1623

/Shaojia Anna Jiang, Ph.D./  
Supervisory Patent Examiner, Art Unit 1623